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Hawkins
PATENT 7/2/03

S/N 09/995,434

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tanay Karnik, et al.

Examiner: Javaid H. Nasri

Serial No.: 09/995,434

Group Art Unit: 2839

Filed: November 27, 2001

Docket: 884.577US1

Title: SIGNALING MEDIUM AND APPARATUS

Assignee: Intel Corporation



RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Restriction Requirement mailed May 27, 2003, the Applicants elect with traverse, Species V (i.e., FIG. 5 and claims 1-8, 11, 14-15, 19-23). The requirement is traversed on the basis that a *prima facie* case for restriction has not been made, and that the requirement does not meet the criteria set forth in the M.P.E.P. for proper restriction between patentably distinct inventions.

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A. A Prima Facie Case for Restriction Has Not Been Made

The United States Patent Office has taken the position that a distinctness requirement between inventions requires division on the basis of (1) separate classification, (2) separate status in the art, or (3) a different field of search. *Patent Prosecution*, Ira H. Donner, 2nd Ed., pg. 1008, 2002. Thus, if "the classification is the same and the field of search is the same, and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." M.P.E.P. § 808.02.

First, it should be noted that the various elements and/or components recited in independent claims 1, 8, 11, 14, 19 include signal conductors, signal terminations, connectors, and circuit boards. Depending on the specific embodiment, each of these elements may be found in classes 174 (Electricity: Conductors and Insulators), 439 (Electrical Connectors), and/or 361 (Electricity: Electrical Systems and Devices). None of these classes spans only one element/component, and not the other. Therefore, since each of the elements/components may be found in the same class, the classification for the claimed embodiments should be the same.

They should have no separate status in the art, and no different field of search should be required.

Second, no indication has been given in the Requirement as to a reason for separate classification, status, or field of search. Since the classification for the claimed embodiments is the same, since they have no separate status in the art, since a different field of search is not required, and since there is no evidence in the record to indicate otherwise, it is respectfully asserted that a *prima facie* case for restriction has not been established. Therefore it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

B. The Restriction Requirement Does Not Meet M.P.E.P. Requirements

The M.P.E.P. § 803 states that the two criteria for restriction between patentably distinct inventions are:

1. inventions must be independent or distinct as claimed; and
2. there must be a serious burden on the examiner if restriction is required.

B.1 The Inventions Must Be Independent Or Distinct As Claimed.

The restriction required is between five alleged patentably distinct species of the claimed embodiments. It is respectfully submitted that the species identified by the Restriction Requirement do not represent distinct "species" of the invention. The M.P.E.P. notes:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristic of such species. MPEP § 806.04(f).

The Restriction Requirement has not identified limitations that are found in the different species which are mutually exclusive.

B.2 There Must Be A Serious Burden On The Examiner If Restriction Is Required.

The Restriction Requirement is also traversed because no *prima facie* case of a serious burden on the Examiner has been established. The M.P.E.P. states, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. § 803. "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." As noted above, when the classification is the same, when the field of search is the same, and when there is no clear indication of separate future classification and field of search (none has been shown), there is no reason to divide related embodiments.

The Applicants believe that the embodiments claimed should be searched as a single group, and respectfully submits that a search of any one of the five asserted species would encompass the subject matter of all species. Thus, a search of all embodiments could be made and the entire Application can be examined without serious burden on the Examiner. Therefore, the Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

C. Provisional Election

The Applicants believe that no proper *prima facie* case for restriction has been made, that the five species identified by the Examiner do not represent distinct "species" of the invention, and that the entire application can be examined without serious burden on the Examiner. However, the Applicants provisionally elect, with traverse, the claims indicated in the Restriction Requirement to be directed to Species V (i.e., FIG. 5 and claims 1-8, 11, 14-15, 19-23). If the Requirement is continued, the Applicants request cancellation of claims 9-10, 12-13, and 16-18

without prejudice or disclaimer, and reserve the right to reintroduce them in this Application, or in one or more divisional applications, at a later date.

The Examiner is invited to contact the Applicants' Representative Mark V. Muller at (210) 308-5677, or the undersigned, if there are any questions regarding this Response or if prosecution of this Application may be assisted thereby. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

TANAY KARNIK, ET AL.

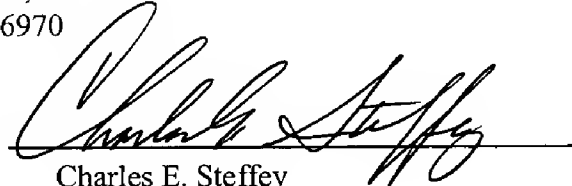
By his Representative,

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Date

June 11, 2003

By



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2833

Applicant: Tanay Karnik et al.

Title: SIGNALING MEDIUM AND APPARATUS

Docket No.: 884.577US1

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Serial No.: 09/995434

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Group Art Unit: 2833

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We are transmitting herewith the following attached items (as indicated with an "X"):

☒ A return postcard.

☒ A Response to Restriction Requirement (4 Pages).

If not provided for in a separate paper filed herewith, Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
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By: Charles E. Steffey
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Reg. No. 25,179

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